

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rocco Fortte, Philipp Stossel, Anja Gerhard and Horst Vestweber

Application No.: 10/573,931 Group: 1625

Filed: August 15, 2006 Examiner: Charanjit Aulakh

Confirmation No.: 5385

For: METAL COMPLEXES

REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

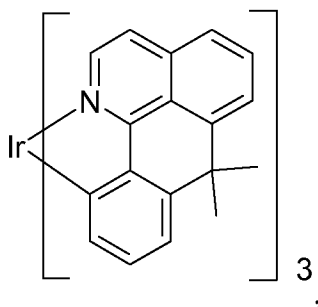
Sir:

Reply to Restriction Requirement

Responsive to the Restriction Requirement dated August 7, 2009, the claims of Group I ((Claims 23-43, in part), drawn to compounds of formulae (2) or (4), where both E and Y represent C, Cy3 and Cy1 rings are 6-membered monocyclic aryl rings and Cy2 ring is a 6-membered heteroaryl ring containing only 1 nitrogen atom where D or D' represents N atom (see examples 1-12 and 16-24), a process for preparing such compounds and methods of using such compounds), are elected for prosecution. Applicant reserves the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicant does not hereby abandon or waive any rights in the non-elected inventions.

Responsive to the requirement for an election of species for searching purposes, Applicant hereby elects as the species *fac*-Tris[7,7-dimethyldibenzo[de,h]quinoline-C²,N] iridium(III) (Ir2), represented by structural formula

-2-



and disclosed in Example 2F, page 27 of the English translation of the instant application as filed. Claims readable on the elected species are 23-31, 38 and 39-43.

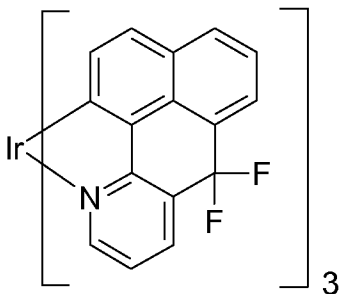
Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

The requirement is being traversed for the reasons set forth in detail below.

Traversal of the Restriction Requirement as Erroneously Excluding the Inventive Compounds

Applicants note that the Examiner's definitions of the seven groups into which the pending claims are being restricted **exclude** subject matter embraced by the pending claims.

Specifically, Applicants note that compound of Example 88, disclosed on page 21 of the English translation of the instant application as filed, represented by the following structural formula



is not included into **any one** of the seven groups into which claims are being restricted, whereas this compound **is** embraced by pending Claim 23.

Indeed, the Examiner defined Group I as requiring Cy1 rings to be 6-membered monocyclic aryl rings, while Cy2 ring is 6-membered heteroaryl ring. However, in the compound of Example 88, Cy1 is a heteroaryl, while Cy2 is an aryl. Thus, the compound of

Example 88 does not fall into Group I. Applicants invite the Examiner to consider Groups II through VII and submit that none of these groups embraces the compound of Example 88.

Because the compound of Example 88 has previously been claimed but is now excluded from the claimed subject matter, and because “it is improper for the Office to refuse to examine that which applicants regard as their invention”¹, the restriction requirement is improper and should be withdrawn.

In the event the Examiner refuses to withdraw the Restriction Requirement, Applicants propose to modify the definitions of Groups I and II as follows:

- I: Claims 23-43, in part, drawn to compounds of formulae (2) or (4) where both E and Y represent C, Cy3 and Cy1 rings are 6-membered monocyclic aryl or heteroaryl rings and Cy2 ring is 6-membered aryl or heteroaryl ring containing only 1 nitrogen atom, where D or D' represents N atom, a process for preparing such compounds and methods of using such compounds;
- II: Claims 23-43, in part, drawn to compounds of formulae (2) or (4) where both E represent C, Y represents O, N, P, Si or B, Cy3 and Cy1 rings are 6-membered monocyclic aryl or heteroaryl rings and Cy2 ring is 6-membered aryl or heteroaryl ring containing only 1 nitrogen atom where D or D' represents N atom (see examples 25-33), a process for preparing such compounds and methods of using such compounds.

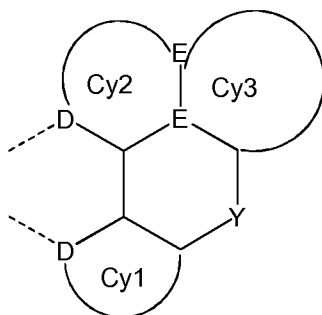
Traversal of the Restriction Requirement Based on PCT Rules 13.1 and 13.2

The instant application is a U.S. National Stage of PCT/EP2004/010836 and, therefore, the restriction practice is governed by PCT Rule 13.1 and 13.2. PCT Rule 13.2 defines the “special technical feature” as a technical feature that defines a contribution which the invention, considered as a whole, makes over the prior art.

As such, in order to show that the claims lack unity of invention, the Examiner needs to demonstrate that the special technical feature is not patentable in view of prior art. The special technical feature of the pending claims is the following moiety:

¹ MPEP §803.02, citing *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978).

-4-

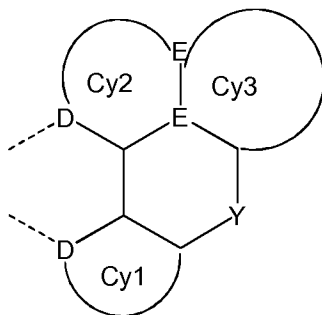


where the symbol ----- denotes an optional bond between atom D and a transition metal atom.

No demonstration that the special technical feature is not patentable in view of prior art has been made. Accordingly, Applicants submit that the restriction is improper and should be withdrawn.

Traversal of the Restriction Between Groups I and II

Applicants also traverse the restriction between Groups I and II. Applicants submit that the compounds embraced by Groups I and II share the common technical feature as argued in the previous section of the instant Reply. Namely, the special technical feature of these two groups is the following moiety:



The difference between Group I and Groups II lies solely in the definition of variable Y, which is a carbon atom (optionally substituted) in Group I and an atom selected from O, N, P, Si, or B (optionally substituted, where chemically permissible) in Group II. Compounds of the two groups differ *only* in the nature of the atom connecting rings Cy1 and Cy3. As such, search and examination of Group II, in addition to Group I places no additional burden on the Office. Therefore, Applicants request that the restriction between Groups I and II be withdrawn.

Additionally, as argued above, the restriction practice for the instant application is governed by PCT Rule 13.1 and 13.2, and PCT Rule 13.2 defines the “special technical feature” as a technical feature that defines a contribution which the invention, considered as a whole,

makes over the prior art. The Examiner has not demonstrated that the special technical feature of Groups I and II, described above, is not patentable in view of prior art.

No demonstration that the special technical feature is not patentable in view of prior art has been made. Accordingly, Applicants submit that the restriction between Groups I and II is improper and should be withdrawn.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By /Alexander Akhiezer – Reg. No. 54,617/

Alexander Akhiezer

Registration No. 54,617

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: September 3, 2009